

1 Laura Handley  
2 Cal. Bar No. 171478  
3 lhandley@mckoolsmith.com  
4 MCKOOL SMITH P.C.  
5 300 W. 6th Street, Suite 1700  
6 Austin, TX 78701  
7 Telephone: (512) 692-8748  
8 Facsimile: (512) 692-8744

9 ATTORNEYS FOR PLAINTIFF WI-LAN INC.

10 UNITED STATES DISTRICT COURT  
11 SOUTHERN DISTRICT OF CALIFORNIA

12 WI-LAN INC.,

13 Plaintiff,

14 v.

15 RESEARCH IN MOTION CORPORATION,  
16 RESEARCH IN MOTION LTD., MOTOROLA,  
17 INC., UTSTARCOM, INC., LG  
18 ELECTRONICS MOBILE COMM U.S.A.,  
19 AND LG ELECTRONICS, INC.,

20 Defendants.

FILED

2010 APR 23 PM 12:08

CLERK US DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

BY [Signature] DEPUTY

10 CV 0859 W CAB  
Misc. No. \_\_\_\_\_

PENDING IN THE UNITED STATES  
DISTRICT COURT FOR THE  
EASTERN DISTRICT OF TEXAS

Civil Action No. 2:08-CV-247

**JURY TRIAL DEMANDED**

**MEMORANDUM AND POINTS OF  
AUTHORITIES IN SUPPORT OF WI-  
LAN INC.'S MOTION TO COMPEL  
THIRD PARTY QUALCOMM,  
INCORPORATED TO PRODUCE  
DOCUMENTS, INFORMATION AND  
OBJECTS**

Judge: \_\_\_\_\_

Courtroom: \_\_\_\_\_

Hearing Date: \_\_\_\_\_

Time of Hearing: \_\_\_\_\_

CP 28  
ORIGINAL

## TABLE OF CONTENTS

		Page(s)
1		
2		
3	BACKGROUND .....	3
4	I. The Underlying Lawsuit and the Subpoena .....	3
5	II. The Protective Order .....	4
6	III. Wi-LAN's Efforts To Compromise .....	4
7	A. The Development Bar .....	5
8	B. The Prosecution Bar .....	6
9	1. <i>Broad Scope of Prohibited Activities</i> .....	6
10	2. <i>The Broad Prohibited Field</i> .....	7
11	3. <i>The Lengthy Duration</i> .....	7
12	4. <i>Qualcomm's Proposed Expansive Prosecution Bar</i> .....	7
13	C. Source Code Printing Protocol .....	8
14	ARGUMENT .....	9
15	I. Qualcomm Should Be Ordered To Produce Its Source Code and Other Confidential Information .....	9
16	A. Qualcomm's Trade Secrets Are Well Protected .....	9
17	B. Qualcomm Cannot Satisfy Its Burden Of Establishing Good Cause For The Restrictions It Seeks .....	10
18	C. Qualcomm's Prosecution And Development Bars Are Unreasonable As A Matter Of Law .....	11
19	D. The Restrictions That Qualcomm Proposes Will Cause Undue Hardship To Wi-LAN .....	11
20		
21		
22	CONCLUSION .....	12
23		
24		
25		
26		
27		
28		

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>CASES</b>	
<i>Avocent Redmond Corp v. U.S.</i> , 85 Fed. Cl. 640 (Fed. Cl. 2009) .....	10, 11
<i>Chan v. Intuit, Inc.</i> , 218 F.R.D. 659 (N.D. Cal. 2003) .....	11
<i>Document Generation Corp. v. Allscripts, LLC</i> , No. 6:08-CV-479, 2009 WL 1766096 (E.D. Tex. June 23, 2009) .....	10
<i>Hochstein v. Microsoft Corp.</i> , No. 04-73071, 2008 WL 4387594 (E.D. Mich. Sept. 24, 2008) .....	11
<i>Island Intellectual Property LLC v. Promontory Interfinancial Network</i> 658 F. Supp. 2d 615 (S.D.N.Y. 2009) .....	11, 12
<i>L.G. Philips LCD Co., Ltd v. Tatung Co.</i> , No. C-07-80073WHA, 2007 WL 869256 .....	10
<i>Mirror Worlds, LLC v. Apple, Inc.</i> , No. 6:08-CV-88, 2009 WL 2461808 (E.D. Tex. Aug. 11, 2009) .....	10

1 This is a miscellaneous action brought pursuant to Federal Rule of Civil Procedure  
 2 45(c)(2)(B)(i) to compel discovery in connection with a lawsuit for patent infringement pending  
 3 in the United States District Court for the Eastern District of Texas, *Wi-LAN, Inc., v. Research in*  
 4 *Motion*, No. 08-Civ-247. Plaintiff Wi-LAN, Inc. ("Wi-LAN") respectfully moves the Court for  
 5 an Order compelling Qualcomm Incorporated ("Qualcomm"), a third-party, to produce source  
 6 code and other technical and business information required by the subpoena, (the "Subpoena,"  
 7 Ex. A<sup>1</sup>), issued from this District to Qualcomm on October 20, 2009 pursuant to an existing  
 8 protective order issued by the United States District Court for the Eastern District of Texas on  
 9 September 1, 2009 ("Protective Order").

#### 10 **PRELIMINARY STATEMENT**

11 Wi-LAN seeks from Qualcomm, a third party, information that is vital to its patent  
 12 infringement claims against the defendant mobile handset manufacturers.<sup>2</sup> Specifically, Wi-  
 13 LAN seeks access to source code and other technical and business information relating to the  
 14 infringing products that Defendants sell (the "Confidential Information"). No one disputes that  
 15 Wi-LAN is entitled to the Confidential Information, most if not all of which is solely within  
 16 Qualcomm's control.

17 Yet Qualcomm refuses to allow Wi-LAN access to the Confidential Information unless  
 18 Wi-LAN agrees to unreasonable conditions that would cripple its ability to pursue its claims.  
 19 Qualcomm proposes, for example, that any expert or consultant who is permitted access to  
 20 Qualcomm's source code must agree to refrain from any commercial product development for  
 21 any company—competitor or not—until 1 year "after the issuance of a final, non-appealable  
 22 decision resolving all issues in the case." At bottom, Qualcomm proposes that Wi-LAN's  
 23 experts and consultants agree to forfeit their careers for the foreseeable future as this case works  
 24 its way through trial and appellate courts. Wi-LAN's experts, as their affidavits make clear,  
 25 simply cannot agree to terms that so significantly threaten their ability to provide for themselves  
 26

27 <sup>1</sup> All Exhibits referred to herein are attached to the Affidavit of Laura Handley.

28 <sup>2</sup> The defendants are Motorola, Inc., UTStarcom, Inc., LG Electronics Mobilecomm U.S.A., Inc., LG Electronics, Inc. and Personal Communications Devices, LLC (collectively referred to herein as the "Defendants").

1 and their families. Wi-LAN has spent over a year locating non-conflicted, competent experts  
2 and getting these individuals up to speed. Acceding to Qualcomm's unreasonable demands is  
3 not an option; Wi-LAN will not be able to find a single competent expert that would agree to the  
4 terms that Qualcomm insists upon.

5 Wi-LAN has made every effort to go above and beyond to accommodate Qualcomm's  
6 purported confidentiality concerns, but Qualcomm remains insistent upon over-reaching  
7 measures that serve no useful end. The Protective Order that is already in place imposes more  
8 than ample restrictions upon Wi-LAN attorneys and consultants to ensure that competitively  
9 sensitive materials, including each company's "crown jewels," are safeguarded. Tellingly, other  
10 wireless chipmakers litigating against Wi-LAN (such as Intel Corp., Broadcom, Atheros and  
11 Marvell)—sophisticated technology companies represented by experienced counsel—all found  
12 the terms of the Protective Order perfectly acceptable. Qualcomm's protestations are simply an  
13 artifice to avoid its discovery obligations.

14 As the party seeking an overly restrictive protective order, Qualcomm bears the burden of  
15 showing the Court that its proposed restrictions are necessary. Qualcomm cannot satisfy that  
16 burden with mere speculation. Accordingly, Wi-LAN respectfully requests that the Court issue  
17 an order requiring Qualcomm to produce all documents, information and things responsive to  
18 Wi-LAN's Subpoena under the terms of the existing Protective Order. In the alternative, Wi-  
19 LAN requests that the Court direct Qualcomm to produce all documents, information and things  
20 responsive to Wi-LAN's Subpoena under the terms of the Protective Order as modified by Wi-  
21 LAN's proposed revisions.

## 22 **BACKGROUND**

### 23 **I. THE UNDERLYING LAWSUIT AND THE SUBPOENA**

24 In June 2008, Wi-LAN commenced patent infringement litigation against leaders in the  
25 mobile handset industry based upon their use of Wi-LAN's patented technology that enables  
26 WiFi capability and wireless data transfer on CDMA-2000 cellular handsets. (See Ex. B.)

27 In October 2009, Wi-LAN issued a third party subpoena to Qualcomm, which  
28 manufactures micro-chips for wireless data transfer used in Defendants' infringing mobile

1 handsets. (Ex. A.) The subpoena included a copy of the Protective Order in place in the Texas  
2 action. The Protective Order expressly protects third parties such as Qualcomm. (*See* Ex. D.  
3 ¶ 41.)

4 Wi-LAN's entitlement to discovery from Qualcomm, including discovery of the source  
5 code used in Qualcomm micro-chips, is undisputed. Qualcomm, however, refuses to produce or  
6 permit inspection of, most notably, its source code. Qualcomm claims that the protections  
7 afforded by the Protective Order are inadequate. (*See* Ex. C at 138.)

## 8 **II. THE PROTECTIVE ORDER**

9 The terms of the Protective Order were agreed upon after more than a year of negotiation  
10 in a case brought by Wi-LAN against chip manufacturers such as Intel styled *Wi-LAN Inc. v.*  
11 *Acer, et al.*, Civ. A. No. 2:07-CV-474(TJW) (E.D. Tex.). (*See* Ex. N.) Many of the attorneys  
12 representing the parties in the above-captioned case were involved in the negotiation of the *Acer*  
13 protective order. The *Acer* protective order was, more or less, adopted as the Protective Order in  
14 this case. (*Compare* Ex. N with Ex. D.) The Protective Order's provisions safeguard the trade  
15 secrets of parties and non-parties alike. (*See* Ex. D ¶ 41.)

16 Other wireless chip manufacturers such as Intel, Broadcom, Marvell and Atheros have  
17 permitted Wi-LAN access to their source code in the *Acer* litigation under the same safeguards  
18 contained in the Protective Order. (Handley Aff. ¶ 15.) Moreover, these manufacturers have  
19 agreed that confidential information produced in the *Acer* litigation may be utilized in this case.  
20 (*See* Ex. O.) While the Protective Order is acceptable to other wireless chip makers with highly  
21 sensitive source code, Qualcomm claims it is insufficient to protect its source code. (*See* Exs. C  
22 at 138, E at 172-73, F at 175.)

## 23 **III. WI-LAN'S EFFORTS TO COMPROMISE**

24 Over the past several months, Wi-LAN has engaged in an extensive dialogue with  
25 Qualcomm, agreeing to incorporate additional safeguards into the already expansive Protective  
26 Order. (*See* Exs. F, G, H, I, J, K.)

27 Notwithstanding Wi-LAN's good faith efforts, Qualcomm remains insistent upon over-  
28 reaching requirements with respect to three provisions: (1) the "Development Bar" (2) the

1 “Prosecution Bar;” and (3) the source code printing protocol. Qualcomm has refused to permit  
2 Wi-LAN access to its Confidential Information code unless it agrees to these provisions.

3 **A. The Development Bar**

4 There are a number of provisions already contained in the Protective Order that prevent  
5 parties from utilizing the competitively sensitive confidential information of the producing party.  
6 The most noteworthy of these is the “Use Restriction” set forth in Paragraph 26. Pursuant to  
7 Paragraph 26, all parties receiving confidential information of a Producing Party must  
8 acknowledge that such information “shall only be used for the purposes of the litigation and shall  
9 not be used in any other way.” (Ex. D ¶ 26). In addition to the Use Restriction, the Protective  
10 Order provides that no employee of any party to the litigation shall be permitted any access to  
11 confidential information produced by third parties like Qualcomm. (*Id.* ¶¶ 7, 11, 16(c).)

12 Despite these safeguards, Qualcomm proposes that, before gaining access to Qualcomm  
13 source code, Wi-LAN’s experts must:

14  
15 *Agree in writing not to perform hardware or software*  
16 *development work or product development work directly or*  
17 *indirectly intended for commercial purposes substantially related*  
18 *to the technology disclosed in Non-Party Qualcomm’s Designated*  
*Materials for a period of one year after the issuance of a final,*  
*non-appealable decision resolving all issues in the case.*

19 (Ex. L at 315 (emphasis added).)<sup>3</sup> Such a provision is referred to as a “development bar”  
20 because it prevents experts and consultants from doing any commercial product development  
21 work in the specified field.

22 Qualcomm’s proposed bar purports to preclude activity in a broad field that could  
23 potentially be construed to include integrated circuits, semi-conductors, microchips and  
24 microprocessors of any type. Therefore, Qualcomm’s overreaching proposal virtually precludes  
25

26  
27 <sup>3</sup> Qualcomm proposed alternative language that is equally unsatisfactory. Specifically,  
28 Qualcomm proposes that Wi-LAN’s agree to refrain from performing “non-litigation-  
related consulting work substantially related to the technology disclosed in . . .  
Qualcomm’s Designated Material, for a period of one year after the issuance of a final,  
non-appealable decision resolving all issues in the case.” (Ex. L at 316.)



1 an electrical engineer from working in any facet of his field of training for an unascertainable  
2 period of time.

3 Wi-LAN advised Qualcomm that the development bar is unreasonable and unacceptable  
4 to its existing experts Richard D. Gitlin, Miguel Gomez, Alexander Haimovich, Thomas Payne  
5 and Trevor Smedley. (*See* Exs. C, F at 174, I at 214-15.) Each of these experts have been  
6 approved by wireless chip makers Intel Corp., Broadcom, Atheros and Marvell and have been  
7 permitted to review their source code under terms identical to those contained in the Protective  
8 Order. Messrs. Gitlin, Gomez, Haimovich, Payne and Smedley have submitted affidavits  
9 explaining that Qualcomm's proposed conditions impose an unreasonable restraint upon their  
10 right to earn a living and that they cannot possibly agree to them. (*See* Ex. P.)

11 Notwithstanding the Protective Order's existing provisions—which also provided that (i)  
12 experts with access to Qualcomm's Confidential Information could not be affiliated with a  
13 Qualcomm competitor, and (ii) any expert who subsequently determined to accept employment  
14 with a competitor would advise Qualcomm in advance—Wi-LAN went the extra mile to further  
15 allay Qualcomm's concerns. (Ex. D ¶¶ 12, 16(d), Atts. A, B.) Most notably, Wi-LAN agreed to  
16 limit the number of experts with access to Qualcomm's Confidential Information. (Ex. I at 214-  
17 15.) This protection was not provided to any of the Defendants or any of the parties in the *Acer*  
18 litigation.

19 Yet Qualcomm insists upon the proposed development bar. While Qualcomm maintains  
20 that the bar is necessary to protect its trade secrets (in contrast to the other wireless chip makers  
21 in Wi-LAN's pending litigation), it has in the past agreed to a protective order that does not  
22 contain such a development bar. (*See* Ex. M.)

### 23 **B. The Prosecution Bar**

24 The Prosecution Bar set forth in the Protective Order is expansive, and can be broken out  
25 into three main components: (1) a broad scope of prohibited activities; (2) a broad field of  
26 subject matter in which activities are prohibited; and (3) a long duration. (*See* Ex. D ¶ 25.)

#### 27 **1. Broad Scope of Prohibited Activities**

28 The Protective provides that:



1 Wi-LAN employees, officers, directors, in-house counsel, experts  
 2 or consultants who personally receive any [Confidential  
 3 Information] . . . ***shall not participate in or be responsible for Wi-***  
 4 ***LAN for preparation or prosecution before a Patent Office of any***  
 5 ***patent, patent application, or for drafting or revising patent***  
 6 ***claims*** (excluding such activities conducted in the context of post-  
 7 grant adversarial proceedings including reexamination or  
 8 opposition proceedings filed in relation to the patents-in suit or  
 9 foreign counterparts).

10 (*Id.* (emphasis added).) This means that any Wi-LAN consultants who review Qualcomm's  
 11 Confidential Information cannot be involved at all in ***any substantive aspect*** relating to the  
 12 drafting of patent applications, or the "prosecution" of such applications with the United States  
 13 Patent and Trademark Office (e.g., the amending of claims or the preparation of written  
 14 responses to objections raised by the patent examiner).

## 15 2. *The Broad Prohibited Field*

16 The "field" that the Prosecution Bar relates to is expansive and covers virtually  
 17 everything within an electrical engineer's area of expertise. Specifically, the relevant field set  
 18 forth in the Protective Order is "wireless or RF communications, DSL, integrated circuits,  
 19 semiconductors, microchips, or microprocessors of any type, or products incorporating those  
 20 items." (*Id.*)

## 21 3. *The Lengthy Duration*

22 The duration of the Prosecution Bar is lengthy and spans

23 ***from the time of receipt . . . through and including one (1) year***  
 24 ***following*** the first to occur of (i) the complete resolution of this  
 25 case through entry of a final non-appealable judgment . . . (ii) the  
 26 complete settlement of all claims against the Producing Party; or  
 27 (iii) the individual person(s) cease to represent the Receiving Party  
 28 or respective client in this case.

(*Id.*)

## 4. *Qualcomm's Proposed Expansive Prosecution Bar*

Qualcomm seeks to vastly expand the pool of persons already subject to the Prosecution  
 Bar. Qualcomm seeks a prosecution bar that must be adhered to by every person—including

outside litigation counsel<sup>4</sup> that are not involved in the prosecution of patents for Wi-LAN or a Defendant. Specifically, Qualcomm proposes that “*any individual*” who personally receives its source code

Shall not participate or be responsible for preparation or prosecution before a Patent Office of any patent, patent application, or for drafting or revising patent claims that are substantially related to the technology disclosed [by Qualcomm] . . . from the time of receipt . . . through and including one year following the first to occur of’ (i) the complete resolution of the case . . . (ii) the complete settlement of all claims in this action; or (iii) the individual persons cease to represent the Receiving Party or respective client in this case.

(Ex. L at 315.) Qualcomm’s proposed bar thus prevents everyone, including non-inventing entities such as law firms, from performing any role in the preparation and prosecution of patents.

Wi-LAN agreed that the terms of the Protective Order should be amended to cover Defendants’ employees, officers, directors, in-house counsel, experts or consultants who were granted access to Qualcomm’s source code, as well as Wi-LAN’s. (See Ex. C at 137.) Wi-LAN, however, advised Qualcomm’s counsel that the provision otherwise imposed an unacceptable restraint upon an attorney’s practice of law. (*Id.*)

### C. Source Code Printing Protocol

The Protective Order contains specific restrictions concerning the manner in which source code may be handled. (Ex. D ¶¶ 21-23.) For example, the Protective Order provides that source code will be made available for inspection only at secure locations, during specified times, and that a log shall be kept tracking any specific requests for printed sections of code. (*Id.* ¶¶ 21, 23.) Notwithstanding these provisions, Qualcomm insists that Wi-LAN agree to, among other things, a maximum number of pages (10) of continuous source code that it may print during the course of its review of Qualcomm’s source code.

<sup>4</sup> (See Ex. D ¶ 11 (defining “Counsel of Record,” which refers to, among others, Wi-LAN’s litigation counsel, McKool Smith P.C).)

Even though Qualcomm historically has not asked for such a limitation, and even though Wi-LAN's experts frequently had to print more than 10 pages of continuous source code during their review of each other chipmaker's source code, Wi-LAN agreed to partially accommodate Qualcomm's request. Specifically, Wi-LAN agreed that it would not print any continuous block of more than 10 pages, but reserved the right to print in excess of 10 pages in situations where necessary to "establish how the code is maintained in the ordinary course of business." (Ex. G at 194 (¶ 25(d)).) Qualcomm rejected this effort to compromise as well.

### **ARGUMENT**

#### **I. QUALCOMM SHOULD BE ORDERED TO PRODUCE ITS SOURCE CODE AND OTHER CONFIDENTIAL INFORMATION**

Given the ample safeguards already imposed under the Protective Order and the additional safeguards Wi-LAN has agreed to, there simply is no basis for Qualcomm's continued refusal to produce its Confidential Information. Any purported concerns that Qualcomm has regarding the safety of its "crown jewels" under the terms of the Protective Order—which has been deemed sufficient by every one of the similarly situated chipmakers—are simply a red herring. Wi-LAN has gone the extra mile, but the protections Qualcomm seeks are overreaching, unreasonable as a matter of law and will result in significant hardship to Wi-LAN.

##### **A. Qualcomm's Trade Secrets Are Well Protected**

The Protective Order, both as currently drafted and including Wi-LAN's proposed additional modifications, ensures that Qualcomm's trade secrets will remain protected. The Protective Order contains scores of restrictive provisions in addition to the certification forms (Ex. D, Atts. A, B), Prosecution Bar (*Id.* ¶ 25), and source code protocol (*id.* ¶¶ 21-23), referenced above, including:

- The Use Restriction providing that all parties receiving confidential information, including source code, of a Producing Party must acknowledge that such information "shall only be used for the purposes of the litigation and shall not be used in any other way." (*Id.* ¶ 26);
- No Wi-LAN employee, nor any Defendant employee will have access to Qualcomm Confidential Information. (*Id.* ¶¶ 7, 11, 16(c))

- Any outside consultants or experts that review Wi-LAN's source code must be pre-approved by the producing party. (*Id.* ¶¶ 19-20)

These protections were good enough for Qualcomm's peers and each of the Defendants. Chip manufacturers Intel, Broadcom, Marvell and Atheros *all* produced source code under such Protective Order terms and have agreed that their materials can be used in the instant case under the Protective Order's terms. (Handley Aff. ¶ 15.)

**B. Qualcomm Cannot Satisfy Its Burden Of Establishing Good Cause For The Restrictions It Seeks**

As the party seeking to limit discovery, Qualcomm must demonstrate "clearly defined and serious injury" that would result in the absence of the provisions that it proposes. *L.G. Philips LCD Co., Ltd v. Tatung Co.*, No. C-07-80073WHA, 2007 WL 869256, at \* 2 (N.D. Cal. Mar. 20, 2007). Otherwise stated, Qualcomm must establish "good cause" why it is entitled to additional protections. *See id.* at \*3; *Mirror Worlds, LLC v. Apple, Inc.*, No. 6:08-CV-88, 2009 WL 2461808, at \*1 (E.D. Tex. Aug. 11, 2009); *Document Generation Corp. v. Allscripts, LLC*, No. 6:08-CV-479, 2009 WL 1766096, at \*2 (E.D. Tex. June 23, 2009) ("When parties . . . agree on entry of a protective order but differ on the order's terms, the party seeking to limit discovery bears the burden of demonstrating . . . 'good cause.'"). When a party seeks protective measures that would bar patent professionals from performing their day-to-day work, such party must establish an "unacceptable opportunity for inadvertent disclosure." *Avocent Redmond Corp v. U.S.*, 85 Fed. Cl. 640, 645-46 (Fed. Cl. 2009).

Qualcomm cannot possibly satisfy its burden here. To be clear, the only party representatives that will have access to its Confidential Information are: (1) litigation counsel, who do not participate in any competitive decision-making on behalf of Wi-LAN; and (2) outside consultants that Qualcomm has pre-approved.<sup>5</sup> Moreover, access will be restricted pursuant to the detailed source code protocol that, among other things, requires logging of every piece of source code that is printed. Qualcomm's cry that the Protective Order does not

<sup>5</sup> As is customary, the Protective Order also provides that the presiding Court in the Eastern District of Texas and court personnel are authorized to review confidential information. Likewise, designated arbitrators and mediators and professional vendors may have access to the materials provided they agree to certify in writing compliance with the terms of the Protective Order.

1 sufficiently protect its Confidential Information thus rings hollow when chipmakers Intel,  
 2 Broadcom, Marvell and Atheros—each of whom would have similar interests in preserving their  
 3 confidential information—found the terms perfectly acceptable. Furthermore, each of these  
 4 chipmakers already has cleared Wi-LAN’s proposed experts. In sum, Qualcomm has not  
 5 suggested to Wi-LAN any facts suggesting an unacceptable opportunity for inadvertent  
 6 disclosure or any clearly defined and serious injury.

7 **C. Qualcomm’s Prosecution And Development Bars Are Unreasonable As A**  
 8 **Matter Of Law**

9 Courts routinely reject sweeping prosecution bars, such as those proposed by Qualcomm,  
 10 as an unreasonable restraint upon the practice of law. *See, e.g., Avocent*, 85 Fed. Cl. at 645-46;  
 11 *Hochstein v. Microsoft Corp.*, No. 04-73071, 2008 WL 4387594, at \*3-4 (E.D. Mich. Sept. 24,  
 12 2008). As recently explained in *Island Intellectual Property LLC v. Promontory Interfinancial*  
 13 *Network*, “Patent prosecution bars . . . are not required when one party simply asserts that  
 14 opposing counsel prosecutes patents involving the same technology at issue in a lawsuit.” 658 F.  
 15 Supp. 2d 615, 617 (S.D.N.Y. 2009); *see also Chan v. Intuit, Inc.*, 218 F.R.D. 659, 662 (N.D. Cal.  
 16 2003) (declining to extend prosecution bar to in-house supervisory patent personnel).

17 The same reasoning applies with equal force to Qualcomm’s proposed Development Bar.  
 18 The provision prohibits an unreasonably broad scope of commercial activity for an unidentified  
 19 period of time—all in the name of protecting secrets that already are well-protected. Under the  
 20 terms of Qualcomm’s proposed development bar, a Wi-LAN expert could resign from the case  
 21 today, but would be unable to do any development work in her field of expertise until one year  
 22 after this litigation ended, which might be 10 years from now. The affidavits of Messrs. Gitlin,  
 23 Gomez, Haimovich, Payne and Smedley establish just how unreasonable Qualcomm’s  
 24 development bar is. (*See Ex. P.*)

25 **D. The Restrictions That Qualcomm Proposes Will Cause Undue Hardship To**  
 26 **Wi-LAN**

27 Any *de minimis* benefit that might arguably result from Qualcomm’s restrictive measures,  
 28 is overwhelmed by the hardship that Wi-LAN, its consultants and litigation counsel would

1 sustain. *See Avocent Redmond Corp v. U.S.*, 85 Fed. Cl. at 645 (citing *U.S. Steel Corp. v. United*  
 2 *States*, 730 F.2d 1465 (Fed. Cir. 1984)).

3 Wi-LAN spent over a year negotiating the Protective Order with chipmaker Intel—which  
 4 negotiated on behalf of defendants that were similarly situated to chipmaker Qualcomm. Wi-  
 5 LAN spent a similar period of time locating experts that were acceptable to those chipmaker  
 6 Defendants. Wi-LAN's counsel and experts already have spent countless hours developing case  
 7 strategy, and some of Wi-LAN's experts have been reviewing source code since May 2009. Wi-  
 8 LAN will lose the value of its investment in these experts if Qualcomm obtains its prohibitive  
 9 Development Bar. With trial less than a year away, Wi-LAN will be back at square one, faced  
 10 with the impossibility of finding competent, non-conflicted experts that are willing to risk their  
 11 livelihood over the next several years.

12 Qualcomm's proposed Prosecution Bar likewise imposes serious hardship upon Wi-  
 13 LAN's litigation counsel. Its expansive scope prevents Wi-LAN's litigation counsel from  
 14 performing *any prosecution work* across a broad field for *any client* for an indefinite period of  
 15 time.<sup>6</sup> Courts have recognized the highly prejudicial impact of such a restraint on litigation  
 16 counsel and rejected requests for prosecution bars virtually identical to the bar Qualcomm seeks  
 17 here. *See, e.g., Island Intellectual Property*, 658 F. Supp. 2d at 620.


### 18 CONCLUSION

19 Qualcomm's Confidential Information, including its source code, is well protected under  
 20 the terms of the Protective Order. Wi-LAN respectfully requests that the Court Order  
 21 Qualcomm to produce its source code to Wi-LAN pursuant to the terms of the Protective Order  
 22 or, in the alternative, under the terms of the Protective Order as modified by Wi-LAN's proposed  
 23 revisions.  
 24  
 25  
 26  
 27

28 <sup>6</sup> Wi-LAN's outside litigation counsel do not currently prosecute patents in the field, but  
 are licensed by the Patent and Trademark Office to do so.

1 Dated: April 21, 2010.

Respectfully submitted,

2   
3 Laura Handley  
4 McKool Smith P.C.  
5 300 W. 6<sup>th</sup> Street, Suite 1700  
6 Austin, TX 78701  
7 Telephone: (512) 692-8744  
8 Fax: (512) 692-8744  
9 *lhandley@mckoolsmith.com*

10 **ATTORNEYS FOR PLAINTIFF**  
11 **WI-LAN, INC.**  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28